

IN THE U.S. PATENT AND TRADEMARK OFFICE

Application No.: 09/477,880 Conf. No.: 9862

Filing Date: January 5, 2000 Group Art Unit: 2154

Applicant: Donald E. Blahut et al Examiner: unknown

Title: INTERNET PROTOCOL BASED NETWORK ARCHITECTURE FOR CABLE
TELEVISION ACCESS WITH SWITCHED FALBACK

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR
§1.181(a) et seq. OR, IN THE ALTERNATIVE TO REVIVE AN
UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R.
§1.137(b)**

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Mail Stop **PETITION**

September 24, 2010

Sir:

I. PETITION TO WITHDRAW

Applicants hereby petitions for withdrawal of the holding of abandonment in the above-identified application because the Notice of Abandonment dated October 9, 2007 was improperly issued.

The Applicants' attorney, John E. Curtin, hereby submits the following statement in support of this Petition. Applicants' attorney requests that the Petition's group telephone the undersigned on (703) 266-3330 prior to its decision on the instant Petition to clarify any issue.

A. STATEMENT BY APPLICANTS' ATTORNEY IN SUPPORT OF PETITION TO WITHDRAW HOLDING OF ABANDONMENT

- 1.) On August 30, 2006 the Applicants timely filed an Appeal Brief (copy enclosed) which, in section VII entitled "SUMMARY OF CLAIMED SUBJECT MATTER" included the independent claims on appeal and provided the required citations to the specification by page and line number following each claim.
- 2.) On September 15, 2006 the Applicants received a Notification of Non-Compliant Appeal Brief ("Notice #1) which indicated that: (a) "[t]he brief does not contain a concise statement of each ground of rejection"; (b) [t]he brief does not present an argument under a separate heading for each ground of rejection"; and (c) "[t]he brief does not contain a correct copy of the appealed claims as an appendix". Because the August 30, 2006 Appeal Brief did in fact contain the subject matter Notice #1 alleged was missing, the Applicants' attorney called the Patent Appeal Center to seek clarification of Notice #1. Upon speaking to the Patent Appeal Center the Center indicated that the Notice #1 was incorrect, and was being withdrawn. The Center further recommended that the Applicants use particular headings in their appeal briefs.
- 3.) On October 16, 2006 the Applicants submitted a corrected version of the Appeal Brief (Correction #1)(attached) which included the headings requested by the Center.
- 4.) On January 3rd, 2007 the Applicants received a second Notification of Non-Compliant Appeal Brief (Notice #2). Notice #2 indicated that "[t]he brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number..". Upon reviewing Correction #1 Applicants' attorney discovered that independent claims 7 and 22 had been inadvertently left out of the SUMMARY OF THE CLAIMED SUBJECT MATTER section.
- 5.) On February 5, 2007 the Applicants' attorney filed a second, corrected version of the Appeal Brief (Correction #2) which included claims 7 and 22 (copy attached).
- 6.) On August 1, 2007 the Applicants received a third Notice of Non-Compliant Appeal Brief (Notice #3). Notice #3 indicated on page 2 that "[t]he appeal filed on 02/05/2007 fails to comply with 37 CFR 41.37, appellant has failed to map each of the limitations of the independent claims to the specification by page and line number...". Because, in fact, Correction #2 did include citations to the specification by page and line number, the Applicants' attorney again called the Center.
- 7.) Upon calling the Center the Center indicated that the specification citations should be placed after each element of the claims, not at the end of each claim.

- 8.) On September 4, 2007 the Applicants' attorney submitted a third, corrected version of the Appeal Brief (Correction #3)(copy attached). This version included specification citations by page and line number following each element of the claims.
- 9.) On October 9, 2007 the Applicants received a Notice of Abandonment stating "[t]he brief does not contain a concised [sic] explanation of the subject matter defined in each independent claim involved in the appeal, referring to the specification by page and line number for each element of the claims". This statement is incorrect. As can be seen in Correction #3, following each element of the claims there is included a specification citation by page and line number.
- 10.) The Applicants' attorney further submits that the process used in reviewing appellate briefs during 2007 was inconsistent, arbitrary, and confusing. For example, attached are appellate briefs submitted by Applicants' attorney dated May 24, 2007, June 20, 2007 and June 25, 2007 in different applications. Each of these appellate briefs was deemed acceptable by the USPTO and none of them included specification citations after each claim element (two were even corrected to correct a "Status of Claims" section, but not the specification citations). Instead, the citations were placed at the end of each claim as in Correction #1 and #2.
- 11.) Believing that the Patent Appeal Center had made a clerical error, and had not received or reviewed the correct set of claims, the Applicants' Attorney began to prepare a petition to withdraw the Notice of Abandonment.
- 12.) During this time the USPTO had announced proposed rule changes to its appeal procedures (*see* page 41472 Federal Register, Vol. 72, No. 145, Monday, July 30, 2007)(attached). Uncertain as to how the new rules might affect the petition, and desiring to avoid duplicate petitions, the Applicants did not immediately file a petition.
- 13.) On June 10, 2008 the proposed rule changes were finalized, with an effective date of December 10, 2008 (*see* page 32938, Federal Register, Vol. 73, No. 112, Tuesday, June 10, 2008) (attached). In the finalized rules, the rules stated that the new rules would apply to "all appeals in which an appeal brief is filed on or after the effective date". This still left unsettled whether in Applicants' petition any *corrected* appeal brief submitted as a part of the petition should comply with the previous appeal rules. On December 10, 2008 the USPTO delayed the implementation of the new appeal rules (*see* page 74972, Federal Register, Vol. 73, No. 238, Wednesday, December 10, 2008, attached).
- 14.) In January, 2009 the Applicants' attorney called Ms. Earlene Green, Special Program Examiner to ask for her assistance on how to proceed with either a petition or resolving the issue without the need for a petition. The Applicants' attorney had previously, successfully worked with Examiner Green to resolve

issues related to other applications without filing a petition. This assistance was greatly appreciated. The Applicants' attorney wrote Examiner Green an email dated April 7, 2009 referring to the instant application and another application as well (copy attached).

15.) As instructed by Examiner Green, on April 9, 2009 the Applicants' attorney spoke with Ms. Sharmela Coates, of the BPAI's processing group. Applicants' attorney requested that Ms. Coates explain the basis of the Notice of Abandonment.

16.) Approximately one week later Ms. Coates telephoned the Applicants' attorney and indicated that the BPAI processing group was not responsible for generating the Notice of Abandonment and, therefore, could not comment on the reasons for issuing the Notice of Abandonment. Ms. Coates referred the Applicants' attorney back to the Examining group.

17.) On April 30, 2009, as suggested by Examiner Green, Applicants' attorney telephoned Special Program Examiner Kenneth Wieder. After explaining the history of the application to Examiner Wieder the Applicants' attorney requested assistance in either filing a petition or resolving the issue without the need to file a petition. The Applicants' attorney sent Examiner Wieder an email dated May 18, 2009 summarizing the Applicants' request along with a number of attachments. (The May 18, 2009 email essentially incorporated Applicants' earlier email to Examiner Green)(copy attached).

18.) On May 6, May 14 and June 10, 2009 the Applicants' attorney telephoned Examiner Wieder to ascertain the status of Examiner's Wieder's investigation. Approximately one week after Applicants' attorney's June 10, 2009 phone call Examiner Wieder telephoned the Applicants' attorney and acknowledged the earlier phone calls, though the Examiner was still reviewing the matter.

19.) On April 10, 2010 the Applicants' attorney telephoned Examiner Wieder to determine the results of the Examiner's investigation. On April 27, 2010 Examiner Wieder telephoned the Applicants' attorney and apologized for the delay in responding, but then indicated that he was no longer responsible for the instant application. Examiner Wieder referred the Applicants' attorney to another Special Examiner.

20.) After speaking with the new Special Examiner, the Examiner requested that the Applicants' file a petition requesting withdrawal of the Notice of Abandonment. This petition followed.

B. REQUEST TO WITHDRAW HOLDING OF ABANDONMENT

As set forth above, the Notice of Abandonment is improper because, contrary to the statement made in the Notice of Abandonment, the Applicants did timely file a corrected

appellate brief that included a concise explanation of the subject matter defined in each independent claim involved in the appeal, referring to the specification by page and line number for each element of the claims (see Correction #3). Further, the Applicants submit that Correction #2 was also an acceptable appellate brief based on the fact that at time Correction #2 was filed, and thereafter for some period of time, the USPTO was accepting appellate briefs that were formatted in the manner Correction #2 was formatted.

Based on all of the above, the Applicant respectfully requests withdrawal of the holding of abandonment in this application.

APPLICANT HEREBY PETITIONS FOR WITHDRAWAL OF THE HOLDING OF ABANDONMENT IN THIS APPLICATION.

1. Petition Fee:

 X No Fee is believed due.

2. Reply and/or Fee:

 X No reply or fee is believed due.

3. Terminal Disclaimer with disclaimer fee

 X Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

If however, a fee is deemed necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any such fee, or credit any overpayment to

Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, petition fees or extension of time fees.

PETITION TO REVIVE

In the event the Applicants Petition to Withdraw is not granted, the Applicants hereby alternatively petition for revival of the above-referenced application. The above-identified application was unintentionally abandoned for failure to file a correct Appeal Brief. The entire delay in filing the correct Appeal Brief, from the due date for filing the correct Appeal Brief until the filing of this petition under 37 CFR 1.137(b) was unintentional. Thus, the abandonment was unintentional.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

1. Petition Fee

Small Entity - fee \$_____ (37 CFR 1.17(m))

Small Entity Statement enclosed herewith.

Small Entity Statement previously filed.

Other than Small Entity - fee **\$1,620** (37 C.F.R 1.17(m)). The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for this fee, or credit any overpayment, to Deposit Account No. 50-3777 as well as for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; **particularly, petition, or extension of time fees.**

2. Reply and/or Fee

Because it is unclear at this point whether Applicants' corrected Appeal Brief will be accepted, the Applicants are filing a Request For Continued Examination, fee and Amendment in response to the last Final Office Action (enclosed).

3. Terminal Disclaimer with disclaimer fee

Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

4. Statement. The entire delay in filing the required corrected Appeal Brief from the due date for the corrected Appeal Brief until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

September 24, 2010

Date:

**/John E. Curtin/
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